



UNITED STATES PATENT AND TRADEMARK OFFICE

14
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,854	01/28/2000	Charles Eric Hunter	WT_6	2737

7590 03/29/2002

Finnegan, Henderson, Farabow
Garrett & Dunner L.L.P
1300 I Street NW
Washington, DC 20005-3315

[REDACTED] EXAMINER

O CONNOR, GERALD J

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2167

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

APR - 4 2002

FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNNER, LLP.

(P)
4/4/02

4-4-02 Attorney REC-MEO
Case No. 08159.0008
Due Date 6-29-02 W/ET
Action RESPONSE DUE
By [Signature]

Office Action Summary

Application No.
09/493,854

Applicant(s)

Hunter et al.

Examiner

O'Connor

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on March 15, 2002 (Reply to Req't for Restriction).

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-97 is/are pending in the application.

4a) Of the above, claim(s) 1-41 and 52-97 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 42-51 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on Jan 28, 2000 is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notices of References Cited (PTO-892) 16) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

Art Unit: 2167

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Invention V (Claims 42-51) in Paper № 11 is hereby acknowledged. The traversal is on the ground(s) that the Restriction Requirement is improper because: "in order for a Restriction Requirement to be proper, [according to MPEP § 803,] the claims must recite independent or distinct inventions, and must present a serious burden on the Examiner." Applicant argues that (1) the instant claims "do not recite inventions which are either independent or distinct within the meaning of M.P.E.P. § 802.01"; and that (2) examination of all claims "would not present a serious burden on the examiner"; and, therefore, that neither of the two conditions necessary for the Restriction Requirement to be proper have been met.

2. Applicant's arguments have been fully considered but they are not persuasive.

3. Regarding the argument that the inventions are neither independent nor distinct, the inventions are indeed distinct, for the reasons thoroughly explained in the Requirement for Restriction. Applicant's arguments have been dismissed as merely spurious, because they amount simply to a general allegation that the claims do not define separately patentable

Art Unit: 2167

(distinct) inventions, without specifically pointing out how the language of the claims fails to comport with the explanation of the examiner vis-à-vis MPEP §§ 806.05(d)-806.05(e).

4. Regarding the argument that examination of all of the claims would not impose a serious burden on the examiner, MPEP § 803 states, in part, under "Guidelines":

A serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

5. As the examiner has indeed made such a *prima facie* showing of serious burden, based upon separate classification, as explained in § 6 of the Restriction Requirement, and as applicant has offered no showing or evidence in rebuttal to that conclusion, simply an opinion stating a contrary position, applicant's arguments have been dismissed as merely spurious, amounting to simply a general allegation that a serious burden would not be imposed, without specifically pointing out how the language of the claims fails to comport with the explanation of separate classification provided by the examiner.

6. The restriction requirement is still deemed proper and is therefore made FINAL.

7. Claims 1-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper № 11.

Art Unit: 2167

8. Newly submitted claims 52-97 are directed to non-elected inventions that are independent or distinct from the invention elected with traverse in Paper N° 11 (Invention V), for the reasons previously set forth in Paper N° 9, making the Requirement for Restriction.

Claims 52-75 are directed to non-elected Invention II.

Claims 76-86 are directed to non-elected Invention I.

Claims 87-97 are directed to non-elected Invention IV.

9. Accordingly, claims 52-97 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper N° 11.

Drawings

10. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the graphical user interface to help customers select music selections for recording, the means to identify music selections by artist, title, and category, the graphical user interface that prompts the customer to insert a recording medium into the user station, the database for storing a multitude of addresses, the association of each of the locations with one of the database addresses, and the means to update music pricing at any time, must all be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

Art Unit: 2167

Specification

11. The very lengthy specification has not been checked to the full extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112, Second Paragraph

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 42-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "central" and "multitude" are relative terms which render the claims indefinite. The terms "central" and "multitude" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Additionally, claim 47 recites the limitation "the customer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2167

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 42-43, 45, and 47-51, as best understood, in light of their rejection under 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schulhof et al. (US 5,557,541).

16. Claims 42-47 and 49-51, as best understood, in light of their rejection under 35 U.S.C. 112, hereinabove, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Allen (US 5,418,713).

Art Unit: 2167

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to the disclosure.

18. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC

gd

March 25, 2002

Robert P. Olszewski 3/25/02

ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600 2100